
To: Ron Jon Surf Shop of Fla., Inc. (lnktm@hotmail.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77411069 - THE STOKED - RJ Museum
Sent: 10/30/2011 2:09:19 PM
Sent As: ECOM109@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 77411069

MARK: THE STOKED



CORRESPONDENT ADDRESS:

LISA N KAUFMAN
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APPLICANT: Ron Jon Surf Shop of Fla.,
Inc.

**CORRESPONDENT'S
REFERENCE/DOCKET NO:**

RJ Museum

CORRESPONDENT E-MAIL ADDRESS:

lnktm@hotmail.com

FINAL OFFICE ACTION - CONTINUED

ISSUE/MAILING DATE: 10/30/2011

THIS IS A FINAL ACTION.

The referenced application is currently the subject of an appeal with the Trademark Trial and Appeal Board (TTAB). However, the TTAB has suspended action on the appeal and has remanded the application to the trademark examining attorney to consider specific facts or issues pertaining to the application. *See* 37 C.F.R. §2.142(d), (f); TMEP §1504.05. In this case, the TTAB has requested that the following issues be considered: (1) an amendment to the identification of goods and services and (2) applicant's additional evidence supporting registration of the proposed mark.

IDENTIFICATION OF GOODS/SERVICES

The amended identification of goods/services is accepted and noted in the record. Please note that applicant's further restriction of the channel of trade does not overcome the refusal to register the proposed mark under Trademark Act 2(d).

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION – Classes 18, 25, 35

The examining attorney has carefully considered applicant's arguments and supporting evidence, but has found them unpersuasive. Therefore, the **final** refusal to register the proposed mark in Classes 18, 25 and 35 is maintained and continued.

Applicant has amended the identification of goods by restricting the channel of trade. However, this restriction does not obviate a likelihood of confusion in this case. If the cited registrations contain no limitations as to their channels of trade or classes of purchasers, then it is presumed that the registrant's goods move in all normal channels of trade and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii). In this case, registrants' goods contain no limitations as to their channels of trade and may be sold anywhere, including applicant's museum stores. The examining attorney provided evidence with her October 13, 2010 denial of applicant's Request for Reconsideration which demonstrates that it is common for the retail store of a museum to sell goods other than promotional items for the museum, itself. This evidence included web pages from the online stores of The Phillips Collection, The Museum of Modern Art, The Art Institute of Chicago, The Museum of Fine Arts, Boston and The Field Museum. In each case, the museum sells jewelry, clothing and a variety of bags that are not promoting the particular museum. In fact, in most cases, these goods are manufactured by third parties and sold by the museum stores.

As previously argued, and supported by evidence attached to the Non-Final Office Action dated March 13, 2011, items sold at museum stores are, in many cases, also sold by stores/retailers unrelated to museums. This evidence includes web pages from the websites of surfing museums which show that such museums sell items, such as books and DVDs about surfing, which a consumer can also purchase at Barnes & Noble®, Target® and Amazon.com®. The examiner also provided evidence that items sold at art and history museums are also sold by third party retailers. For instance, The Smithsonian Store sells a Rawlings® leather wallet that is manufactured by and sold by Rawlings®. The Smithsonian Store sells a Tiffany lamp inspired umbrella which can also be purchased from Walmart®. The Museum of Modern Art sells a "Tord Boontje" charm necklace; as does a seller on Amazon.

As previously explained, applicant's mark, THE STOKED, is highly similar in sound, spelling, appearance, and commercial impression to the mark used in the cited prior registration, STOKED. The only difference between these two marks is the article THE which has no trademark significance whatsoever and does nothing to obviate the potential for confusion. Despite applicant's arguments to the contrary, the term STOKED is simply not weak in connection with the identified goods and services, even as amended. Applicant contends that the examining attorney "appears to have disregarded" the significance of the word STOKED in the context of the board sports industry. The examining attorney has not disregarded the significance; rather, it is this examiner's position that the meaning/significance of the term STOKED to the surfing community does nothing to overcome this refusal. Applicant has provided additional evidence consisting of a page from an online publication, "The Word Detective," describing the origins of the word STOKED. This evidence does not persuade the examiner that the proposed mark is weak in connection with the identified goods and services. The word STOKED is defined by mainstream dictionaries, such as *The American Heritage Dictionary*® and *Merriam-Webster's*®, as "exhilarated and excited." "Stoked" may be a common term used among surfers, but the term also has meaning and use outside of the surf community. The slang term is used by surfers and non-surfers, alike, to describe an emotion. Evidence to support the examiner's position was provided in connection with the examiner's March 13, 2011 Non-Final Office Action. Based on the foregoing, as well as the arguments and evidence previously made of record, the **FINAL** refusal to register, as to Classes 18, 25 and 35, under Trademark Act 2(d) is **maintained and**

continued.

The application will be forward to the Trademark Trial and Appeal Board for resumption of the appeal.

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All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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